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| 7590 01/17/2008 | | | | |
| Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201 | | | | |
| | | | EXAMINER SHEWAREGED, BETELHEM | |
| | | | ART UNIT 1794 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,511

Applicant(s)

CAMPBELL ET AL.

Examiner

Betelhem Shewareged

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,9,11 and 13-27 is/are pending in the application.
- 4a) Of the above claim(s) 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,9,11,13-21,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 11/08/2007 has been fully considered. Claim 1 is amended, claims 2-4, 6-8, 10 and 12 are canceled, and claims 1, 5, 9, 11 and 13-27 are pending. Currently, claims 22-25 are withdrawn from consideration as non-elected invention.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5, 9, 11, 13-21, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (US 6,695,447 B1) as evidenced by Landry-Coltrain et al. (US 6,497,941 B1) in view of King et al. (US 6,902,268 B1).

4. Wexler discloses an ink jet recording element comprising a support, an ink carrier liquid receptive layer on the support, a dye trapping layer on the ink carrier liquid receptive layer and an ink transporting layer on the dye trapping layer (abstract). The dye trapping layer meets the claimed porous ink receptive layer. The combination of the ink carrier liquid receptive layer and the support meets the claimed porous support of an adjacent layer that is either paper or a voided extruded polymeric film that is extruded, including optional co-extrusion with additional underlying layers in the support, wherein the adjacent layer forms the upper surface of the support and is the porous layer

contiguous or in contact with the image-receiving layer. Preferably, if the upper layer is coextruded, the coextruded portion also comprises at least 80%, preferably at least 90% of the thickness of the element. The ink carrier liquid receptive layer and the support of Wexler are described in col. 5, line 19 thru col. 6, line 26, and the evidence has been shown in the reference of Landry-Coltrain. The dye trapping layer comprises polymeric particles having a particle size of 0.1-10um, a binder and mordant (col. 3, line 41 thru col. 4, line 58). The thickness of the dye trapping layer ranges from 2-50um (col. 5, line 15). With respect to the Bristow Test absorption value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since the Wexler reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article functions in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

5. Wexler does not disclose the dye trapping layer is the only layer above the support. However, King teaches an ink jet recording medium comprising a substrate and a single fusible ink receiving layer rather than minimum of two layers known previously (col. 2, lines 18-31). Wexler and King are analogous art because they are from the same field of endeavor that is the ink jet recording sheet art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the ink transporting layer and the ink trapping layer of Wexler and form a single fusible

ink accepting layer because as King suggests, forming a single layer rather than two layers is considerably simpler and cheaper to manufacture (col. 2, lines 30-35).

6. Alternatively, the Office realizes that all of the claimed effects or physical properties are not positively stated by the reference(s). However, the reference(s) teaches all of the claimed ingredients. Therefore, the claimed effects and physical properties, i.e. Bristow Test absorption value of porous support and Bristow Test absorption value of ink receptive layer would implicitly be achieved by a composite with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

Response to Arguments

7. Applicant's argument is based on that each of the three layers in Wexler are essential and required. There is no teaching in Wexler as to how any one of the layers can be eliminated or combined into a single layer. This argument is not persuasive because eliminating/combining into a single layer is taught by the reference of King, and the motivation to do so is disclosed in King (see col. 2, lines 30-35 of king).

8. Applicant further argued that King does not remotely teach the claimed Bristow Test absorption value(s). This argument is not persuasive because King does not expressly disclose any Bristow Test absorption value; however, the claimed porous

support is taught by Wexler (col. 5; line 19 thru col. 6, line 26), and since Wexler teaches all of Applicant's claimed compositional and positional limitations of the porous support, it is inherent that the reference article functions in the same manner claimed by Applicant. In the alternative, the reference(s) teaches all of the claimed ingredients, thus the claimed effects and physical properties, i.e. Bristow Test absorption value of porous support and Bristow Test absorption value of ink receptive layer would implicitly be achieved by a composite with all the claimed ingredients.

9. Applicant also argued that present claim 21 requires a hydrophobic film forming binder; however, King prefers a hydrophilic binder and, in fact, uses a hydrophilic binder in the examples, namely poly(vinyl alcohol). This argument is not persuasive because the reference of King has never been used teach the claimed hydrophobic film forming binder. The claimed binder and the claimed amount of binder are taught by Wexler (col. 4, lines 11 and 50).

10. In addition, Applicant argued that the claimed porous support of claim 21 has never been disclosed by King. This argument is not persuasive because King has never been used to teach the claimed porous support.

11. For the above reason claims 1, 5, 9, 11, 13-21, 26 and 27 stand rejected.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.


15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS
January 14, 2008.


BETELHEM SHEVAREGED
PRIMARY EXAMINER